IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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In re application of :
Conkwright, et al. : Group Art Unit: 2172
Serial No.: 10/020,512 : Examiner: Unassigned
Filed: December 18, 2001 :
Atty. Docket No. 37865.010400 :
For: Privacy Compliant Multiple Dataset Correlation System and Content Delivery
    System and Methods

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Honorable Assistant Commissioner for Patents
Washington, D.C. 20231

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Technology Center 2100

PETITION TO MAKE SPECIAL UNDER 37 C.F.R. §1.102(d)

Sir:

As provided for in 37 CFR 1.102(d), Applicants hereby petition to make the above-referenced patent application special and advance it out of turn for examination. The claims of the above referenced patent application are directed to a single invention and place the application in condition for allowance by the Examiner. Should the Commissioner determine that the application is directed to multiple inventions, Applicants will agree to an election without traverse.

Applicant has performed a pre-examination search in Class 725, subclasses 12, 14, 18, 24, 34, and 35; Class 707, subclass 104.1; and Class 705, subclass 10. Copies of references deemed most closely related to the subject matter encompassed by the claims of the present application are attached hereto. A detailed discussion of the references which points out, with the particularity required by 37 C.F.R. §§1.111(b) and (c), how the claimed subject matter is patentable over the references is presented below.

REMARKS

U.S. Patent No. 5,872,588, to Aras, et al. ("the '588 patent"), teaches a method and apparatus for content coding of audio-visual materials. An audio-video material distribution system is described in which content coded audio-visual material streams are supplied to home stations within subscriber homes via a local distribution network. The home stations decode, collect, and process content codes as they are received. In one aspect of the '588 patent, content codes are used to control aspects of

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the home station, thereby providing management of an upstream channel between the home stations and the video distribution node. The home stations also utilize decoded content codes to collect information on the audio-visual material streams selected by a subscriber and to record which audio-visual material has been presented to the subscriber. The collected content codes are then sent to collection centers for processing.

Applicants' invention is patentable over the '588 patent. Applicants' invention is generally directed to an individually targeted content delivery method in which content is selected and presented by a set top box based on correlations between attributes of the content and one or more user models associated with the set top box. To assist in selecting appropriate content for display by a set top box, set top box user models are derived from data associated with the set top box. The '588 patent does not teach or suggest causing a set top box to present individually targeted content. The Court of Appeals for the Federal Circuit has consistently held that "Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim." Lindemann Maschinenfabirk Gmbh v. American Hoist & Derrick, 221 USPQ 481, 485 (Fed. Cir. 1984). The '588 patent clearly fails to disclose each and every element of Applicants' claimed invention.

U.S. Patent Application No. 2001/0020236, to Cannon ("the '236 application"), teaches a computer system for manipulating and analyzing viewer data supplied by Nielson Media Research Service for decision-making purposes. The system comprises four main components: a database mining engine, a database, an optimization mechanism, and a user interface which controls the system and allows a user to manipulate and analyze the data in the database by using the database mining engine. The database-mining engine converts Nielson viewer data into a proprietary format before storing the data in the database. The '236 application teaches that this proprietary data format can allow for faster searches within the database.

Applicants' invention is patentable over the '236 application. Applicants' invention is generally directed to an individually targeted content delivery method in which content is selected and presented by a set top box based on correlations between attributes of the content and one or more user models associated with the set top box. To assist in selecting appropriate content for display by a set top box, set top box user models are derived from data associated with the set top box. The '236

application does not teach or suggest selecting content for delivery to a set top box based on correlations between content attributes and derived user models. It is well established that, in order to show obviousness, all limitations in the claim must be taught or suggested by the prior art. In Re Boyka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974); MPEP § 2143.03. It is error to ignore specific limitations distinguishing over the references. In Re Boe, 184 U.S.P.Q. 38, 505 F.2d 1297 (C.C.P.A. 1974); In Re Saether, 181 U.S.P.Q. 36, 492 F.2d 849 (C.C.P.A. 1974); In Re Glass, 176 U.S.P.Q. 489, 472 F.2d 1388 (C.C.P.A. 1973). The '236 application clearly does not disclose all the limitations in Applicant's claims.

U.S. Patent No. 4,931,865, to Scarampi ("the '865 patent"), teaches an apparatus and methods for monitoring television viewer behaviors. The apparatus transmits a signal toward an individual and detects the reflection of the signal from the individual's eyes to determine the time intervals and total times the individual is viewing the television. The viewing information is then correlated with program information from a television. The information collected is used to identify individuals viewing a television program and to track and correlate the viewing information for each individual. The information can also be used to determine changes in blink rate and/or pupil dilation in order to determine the emotional response of each individual to the program being viewed. The patent also discloses a system for monitoring the times at which particular individuals view particular programs even when the individual records the program on a VCR and views the program at a later time.

Applicants' invention is patentable over the '865 patent. Applicants' invention is generally directed to an individually targeted content delivery method in which content is selected and presented by a set top box based on correlations between attributes of the content and one or more user models associated with the set top box. To assist in selecting appropriate content for display by a set top box, set top box user models are derived from data associated with the set top box. The '865 application does not teach or suggest selecting content for delivery to a set top box based on correlations between content attributes and derived user models. It is well established that, in order to show obviousness, all limitations in the claim must be taught or suggested by the prior art. The '865 patent clearly does not disclose all the limitations in Applicant's claims.

U.S. Patent No. 5,319,455, to Hoarty, et al. (" the '455 patent"), teaches an interactive multimedia system with distributed processing and storage of video picture information and associated data and sound in nodes disposed throughout a cable television distribution system. The nodes are coupled to a feeder cable of a cable distribution system. Each node in the system receives a substantially identical copy of the interactive video picture information and related data from a regional processing center. The nodes can also be used for decompressing compressed television programming and distributing the decompressed programming to home televisions connected to the system. The '455 patent also teaches that the nodes can also be programmed to provide customized advertising of users of the system during the commercial time of ordinary cable television commercials. In such an implementation, users watching a particular program would automatically be switched to a virtual channel over which a commercial customized for their particular demographic location would be transmitted. In this manner, advertisers could prepare a variety of commercials targeted to different demographic groups, such that the commercial viewed by one class of users would be customized to the interests of those viewers, while other viewers would see a different commercial customized for their purchasing habits.

Applicants' invention is patentable over the '455 patent. Applicants' invention is generally directed to an individually targeted content delivery method in which content is selected and presented by a set top box based on correlations between attributes of the content and one or more user models associated with the set top box. To assist in selecting appropriate content for display by a set top box, set top box user models are derived from data associated with the set top box. The '455 application does not teach or suggest selecting content for delivery to a set top box based on correlations between content attributes and derived user models. It is well established that, in order to show obviousness, all limitations in the claim must be taught or suggested by the prior art. The '455 application clearly does not disclose all the limitations in Applicant's claims.

U.S. Patent No. 5,758,257, to Herz et al. ("the '257 patent") teaches a system and method for scheduling the broadcast of movies and other forms of data from a network that simultaneously distributes many sources of such data to many customers, as in a cable television system. Customer profiles are developed for the recipient describing how important certain characteristics of the broadcast video program,

movie or other data are to each customer. From these profiles, an agreement matrix is calculated by comparing the recipient's profiles to the actual characteristics of the available video programs. The agreement matrix thus provides a characterization of the attractiveness of each video program to each prospective customer. Available video programs are then scheduled for broadcast using a proprietary scheduling technique such that a "virtual channel" is created which provides the greatest satisfaction to all customers or a subset of customers. The actual viewership of these virtual channels is monitored, and program attributes and customer profiles are modified based on the viewership.

Applicants' invention is patentable over the '257 patent. Applicants' invention is generally directed to an individually targeted content delivery method in which content is selected and presented by a set top box based on correlations between attributes of the content and one or more user models associated with the set top box. To assist in selecting appropriate content for display by a set top box, set top box user models are derived from data associated with the set top box. The '257 patent does not teach or suggest causing a set-top box to present content to a user. Instead, the '257 patent requires that a user select from a list of available content, with content which the system described in the '257 patent identifies as potentially of interest to the user highlighted or otherwise indicated in the list. It is well established that, in order to show obviousness, all limitations in the claim must be taught or suggested by the prior art. The '257 application clearly does not disclose all the limitations in Applicant's claims.

U.S. Patent No. 5,155,591, to Wachob ("the '591 patent") teaches a method and apparatus for providing demographically targeted television commercials. The '591 patent teaches that a first television channel, containing television programs and periodic commercial messages, can be broadcast to a cable television viewer. A second television channel can also be broadcast which contains alternate commercial messages. Demographic characteristics of a viewer are identified, and commercial messages are selected from the first or second channel, depending on the viewer's demographic characteristics.

Applicants' invention is patentable over the '591 patent. Applicants' invention is generally directed to an individually targeted content delivery method in which content is selected and presented by a set top box based on correlations between attributes of the content and one or more user models associated with the set

top box. To assist in selecting appropriate content for display by a set top box, set top box user models are derived from data associated with the set top box. The '591 patent does not teach or suggest the derivation of user models based on data associated with at least one set top box; rather the '591 patent requires that viewer demographic types be input and stored into the memory of a cable television converter or the like. It is well established that, in order to show obviousness, all limitations in the claim must be taught or suggested by the prior art. The '591 application clearly does not disclose all the limitations in Applicant's claims.

U.S. Patent No. 6,169,542, to Hooks et al. ("the 542 patent") teaches an interactive video distribution system which includes a plurality of video subscriber units, a head end facility, and a video distribution medium. The head end facility is configured to transmit advertisements in conjunction with an interactive video program and receive requests from one of the subscriber units to register the advertisements in a menu. In response to each of the requests, the head end facility generates entries associated with the advertisements in a menu. The menu is communicated in a video still image to the subscriber unit through the video distribution medium. The head end facility is further configured to obtain a selection request for one of the generated entries and provide supplementary advertising information associated with the selected advertisements to the subscriber unit.

Applicants' invention is patentable over the '542 patent. Applicants' invention is generally directed to an individually targeted content delivery method in which content is selected and presented by a set top box based on correlations between attributes of the content and one or more user models associated with the set top box. To assist in selecting appropriate content for display by a set top box, set top box user models are derived from data associated with the set top box. The '542 patent does not teach or suggest a method of delivering individually targeted content to users. It is well established that, in order to show obviousness, all limitations in the claim must be taught or suggested by the prior art. The '236 application clearly does not disclose all the limitations in Applicant's claims.

U.S. Patent No. 6,298,348, to Eldering ("the '348 patent") teaches a system which learns the buying habits of consumers based on data received from a point of purchase, such as a register in a grocery store. The '348 patent teaches that such point of purchase data can be used to develop consumer demographic profiles using a vector-based representation of the probability that a consumer falls within a certain

demographic category such as an age group, gender, household size, or income range. The '348 patent also teaches that a consumer's product preferences can also be discerned from the learned buying habits to determine which products a consumer is likely to purchase in the future. The demographic profile and product preferences are updated with each purchase. The updating process uses a weighting factor that determines the importance of the purchased product with respect to all of the products purchased in a particular product category. The '348 patent also teaches that print advertisements can then be targeted to a consumer based on the consumer's demographic profile and product preferences.

Applicants' invention is patentable over the '348 patent. Applicants' invention is generally directed to an individually targeted content delivery method in which content is selected and presented by a set top box based on correlations between attributes of the content and one or more user models associated with the set top box. To assist in selecting appropriate content for display by a set top box, set top box user models are derived from data associated with the set top box. The '348 patent does not teach or suggest collecting data associated with at least one set top box and deriving at least one user model from such data. The Court of Appeals for the Federal Circuit has consistently held that "Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim." Lindemann Maschinenfabirk Gmbh v. American Hoist & Derrick, 221 USPQ 481, 485 (Fed. Cir. 1984). The '348 patent clearly fails to disclose structure positively recited and claimed in applicant's independent claims.

U.S. Patent No. 6,216,129, to Eldering ("the '129 patent") teaches an advertisement selection system in which vectors describing an actual or hypothetical market for a product or desired viewing audience can be determined. A consumer characterization vector is correlated with an ad characterization vector to determine the suitability of the advertisement to a specific consumer. The consumer characterization vector describes statistical information regarding the demographics and product purchase preferences of a consumer, and is developed from previous purchases or viewing habits.

Applicants' invention is patentable over the '129 patent. Applicants' invention is generally directed to an individually targeted content delivery method in which content is selected and presented by a set top box based on correlations between attributes of the content and one or more user models associated with the set

top box. To assist in selecting appropriate content for display by a set top box, set top box user models are derived from data associated with the set top box. The '129 patent does not teach or suggest collecting data associated with at least one set top box and deriving at least one user model from such data. The Court of Appeals for the Federal Circuit has consistently held that "Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim." Lindemann Maschinenfabirk Gmbh v. American Hoist & Derrick, 221 USPQ 481, 485 (Fed. Cir. 1984). The '129 patent clearly fails to disclose structure positively recited and claimed in applicant's independent claims.

U.S. Patent Application No. 2001/0021994, to Nash ("the '994 application"), teaches a television system which enables advertisements to be targeted at viewers who have a particular interest in the products or services being promoted by the advertisement which comprises reviews from a plurality of reviewers commissioned by the advertiser and alternatively or additionally by independent reviewers. These reviews are encoded into a data channel associated with the advertisement. A product rating decoder is provided in a receiver which decodes the data in the data channel and selects advertisements for display based on the data and a user profile generated either explicitly by the user entering preferences via a user interface or implicitly by monitoring the type of program selected for viewing by the user as defined by the expert reviewers.

Applicants do not believe the '994 application is proper prior art against the present application under 35 U.S.C. §§102 and 103 because Applicants' filing and priority dates predate those of the '994 application.
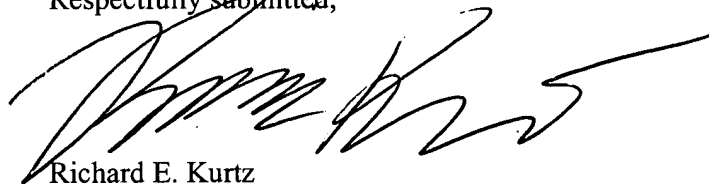
U.S. Patent Application Publication No.: 2001/0049620, to Blasko ("the '620 publication"), teaches a system and method for transaction profiling in a privacy-protected manner based on transaction data, wherein the transaction generally refers to an intentional action by a user. The '620 publication teaches that transaction data relates to programming and advertisements watched by the user over a predetermined period of time. Transaction profile vectors are computed based on the transaction data, wherein the transaction profile vector may include demographic attributes such as age, household size, income level of the user, or preference attributes indicating probable products and services preferred by the user. The '620 publication teaches that the transaction profile vector preferably takes place local to the transaction.

Applicants do not believe the '620 publication is proper prior art against Applicants' invention. Applicants believe that the '620 publication is not valid prior art under 35 U.S.C. §§102 or 103 because Applicants' filing and invention dates predate the filing and priority dates of the '620 publication.

CONCLUSION

Through the discussion above, Applicants have met the requirements set forth under 37 CFR 1.102(d) by pointing out, with the specificity required by 37 CFR 1.111(b) and (c), how Applicants' invention is patentable over the references discovered during a prior art search. Therefore Applicants request that this petition be granted. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicants' undersigned representative to expedite the prosecution. You are hereby authorized to charge or credit any deficiency or overpayment to our Deposit Account No. 50-0653.

Respectfully submitted,

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Filed: June 17, 2002

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Atty's Docket No. 37865.010400

In re application of: Conkwright et al.
Serial No.:   10/020,512
Filed: December 18, 2001
For: Privacy Compliant Multiple Dataset Correlation System and Content Delivery System and Methods
ASSISTANT COMMISSIONER FOR PATENTS
Washington, D.C. 20231

Sir:

Transmitted herewith is a petition to make special in the above-identified application.

☒ Applicant claims the benefit of Small Entity Status..

☐ Verified statement(s) to establish small entity status under 37 C.F.R. §1.9 and §1.27 enclosed.

☒ Eleven references.

PETITION FEE	130.00
TOTAL FEES DUE	130.00

☐ The amount of $ _____ is included in the attached check.

☒ Please charge my Deposit Account No. 50-0653 in the amount of $ **130.00**. Two copies of this sheet are attached for this purpose.

Applicant(s) request(s) that the time for taking action in this case be extended pursuant to 37 C.F.R. §1.136(a).

☐ Included in the attached check is the statutory fee of $ **0** for an extension of time for months.

☒ If the box for the sentence immediately above is marked but no check is attached, then charge the statutory fee recited in such sentence for an extension of time of the number of months recited in such sentence to Deposit Account No. 50-0653. Two copies of this sheet are attached for this purpose.

☐ Charge the Statutory Fee of $_____ for an extension of time of _____ month(s) to Deposit Account No. 50-0653.

☒ The Commissioner is hereby authorized to charge any deficiencies in payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 50-0653:

☒ Any filing fees under 37 C.F.R. §1.16 for the presentation of extra claims.

☒ Any patent application processing fees under 37 C.F.R. §1.17.

Respectfully submitted,

Greenberg Traurig

DATE: June 17, 2002   BY:_____

Richard E. Kurtz